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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/627,522	07/28/00	TAYLOR M	510553.90940

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IM31/0227

EXAMINER	
DOVE, T	
ART UNIT	**PAPER NUMBER**
1745	5

DATE MAILED: 02/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/627,522	Applicant(s) Taylor et al.
	Examiner Tracy Dove	Group Art Unit 1745

☒ Responsive to communication(s) filed on *28 Jul 2000*.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *30-56* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *30-56* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 30-56 are rejected under the judicially created doctrine of double patenting over claims 1-33 of U. S. Patent No. 6,117,594 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: both the instant application and the patent are directed toward a grid for a lead acid battery having a lead based alloy of lead, tin, calcium and silver. The only difference between the claims of the instant invention and the claims of the patent is in the range of silver contained

in the lead based alloy. The silver range of greater than 0 to about 0.02% (instant invention) was narrowed during the prosecution of the patent to a silver range of greater than 0 to about 0.015%.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 30-38, 40-52 and 54-56 are rejected under 35 U.S.C. 102(e) as being anticipated by and alternatively under 35 U.S.C. 103(a) as being unpatentable over Rao et al. 5,874,186.

Rao et al. discloses lead-acid batteries having grids made from calcium-tin-silver lead-based alloys in which the alloy composition is carefully selected based upon the grid manufacturing technique of choice and the battery service application. Thus, for such directly cast strip positive grids, it has been found that alloys of the following composition, based upon the total weight of the fabricated grid, are suitable: about 0.030 to 0.050% calcium, from about 0.65 to 1.25% tin, from about 0.018 to 0.030% silver, and the remainder lead (see abstract). Aluminum can be optionally included in an amount from about 0.004 to about 0.01% (col. 9, lin 54-57). Alternatively for gravity casting of the grid, the alloy composition of the grid is: 0.035 to 0.055% calcium, about 0.95 to about 1.45% tin, about 0.018 to about 0.030% silver, and the remainder lead, all of the percentages being based upon the total weight of the grid. Rao teaches many alternative compositions for the lead-based alloy grid depending on the technique which is used to manufacture the grid. See col. 9, line 45 through col. 10, line 8. The use of the grid in sealed and maintenance free batteries is taught. When the battery grids are made by continuous strip casting the lead based alloy is: calcium in the range of from 0.030 to 0.050%, tin in the range of from 0.95 to 1.25% and silver in the range of from 0.017 to 0.030% (see abstract).

Thus the claims are anticipated.

The portions of the claimed ranges of calcium, tin and/or silver which are not contained within the ranges of Rao are alternatively unpatentable. The instant claims and the Rao patent use language such as "about"when describing and claiming the ranges of calcium, tin and silver in the lead based alloy. Language such as "about" is interpreted broadly when applying prior art.

Claims 39 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rao US 5,874,186.

See discussion of Rao above.

Rao does not explicitly state the range of silver is from about 0.008 to about 0.015%.

However, the invention as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made because the skilled artisan would have known that "about 0.02%" or "about 0.017%" renders the claimed silver range of "about 0.008 to about 0.015%" obvious. The instant claims and the Rao patent use language such as "about"when describing and claiming the ranges of calcium, tin and silver in the lead based alloy. Language such as "about" is interpreted broadly when applying prior art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracy Dove whose telephone number is (703) 308-8821. The Examiner may normally be reached *Monday-Thursday from 8:00 AM - 6:30 PM.* My supervisor is Gabrielle Brouillette, who can be reached at (703) 308-0756. The Art Unit receptionist can be reached at (703) 308-0661 and the official fax number is (703) 305-3599.

February 15, 2001

G. Brouillette

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